REMARKS

Claims 1-21 are pending in this application. Claims 1-3 are currently being examined and claims 4-21 are withdrawn from consideration. By this Amendment, claims 1-3 are amended. No new matter is added.

I. Restriction Requirement

Applicants affirm election of Group I, claims 1-3, with traverse.

It is respectfully submitted that the subject matter of all claims 1-21 is sufficiently related that a thorough search for the subject matter of any one Group of claims would encompass a search for the subject matter of the remaining claims. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

Thus, withdrawal of the Restriction Requirement is respectfully requested.

II. Specification Objection

The Office Action objects to the abstract and to the title as being non-descriptive of the claimed invention. In particular, the Office Action states that: "It is noted that the claimed invention is directed solely to a method. The examiner suggests amending the title/abstract to reflect the same." Applicants respectfully traverse the objection.

Although this application is under a Restriction Requirement, and although elected Group I only contains method claims 1-3, the remaining claims 4-21 remain pending in this application. Furthermore, Applicants traverse the Restriction Requirement above in Section

I. Thus, the pending claims of this application are **not** directed solely to method claims. In contrast, this application contains both method claims and product claims. Accordingly, the Abstract and title are sufficiently descriptive of the claimed invention. Reconsideration and withdrawal of the objection is respectfully requested.

III. §112, Second Paragraph, Rejection

The Office Action rejects claims 1-3 under 35 U.S.C. §112, second paragraph, as being indefinite. By this Amendment, claims 1-3 are amended as suggested by the Office Action. Reconsideration and withdrawal of the rejection are respectfully requested.

IV. §103 Rejection over US 704

The Office Action rejects claims 1-3 under 35 U.S.C. §103(a) as being obvious over US 704 (U.S. Patent No. 6,187,704 to Takahashi). Applicants respectfully traverse the rejection.

A. US 704 Does Not Teach or Suggest the Claimed Placing Steps

Claim 1 recites: "placing, in a first closed space, an organic compound having sublimation properties and an affinity for a resin of the molded resin article to be coated," and "placing the molded resin article in a second closed space. US 704 does not teach or suggest these placing steps, as required by claim 1.

US 704 discloses a process for making a heater member obtained by sintering a mixture of silicon carbide powder and a non-metal-based sintering auxiliary. See the abstract. US 704 further discloses that the auxiliary is preferably an organic compound that produces carbon upon heating. See col. 2, lines 38-39 and col. 5, lines 58-61. The Office Action argues that the silicon carbide corresponds to the claimed molded article, and that the auxiliary corresponds to the claimed organic compound.

However, US 704 requires mixing the silicon source, the auxiliary, and a catalyst in a single container and sintering the mixture in that container to form the heater member. See,

for example, col. 2, lines 48-55, col. 3, lines 51-58, col. 5, lines 16-20, and col. 7, lines 22-25 and 42-49. US 704 does not teach or suggest placing the auxiliary in a first closed space and placing the silicon carbide in a second closed space.

Accordingly, US 704 does not teach or suggest "placing, in a first closed space, an organic compound having sublimation properties and an affinity for a resin of the molded resin article to be coated," and "placing the molded resin article in a second closed space," as required by claim 1. For at least this reason, US 704 does not teach or suggest every feature of claim 1. Claims 2 and 3 depend from claim 1 and include all of its features. Accordingly, US 704 does not teach or suggest every feature of these dependent claims for at least the same reasons as claim 1.

B. US 704 Does Not Teach or Suggest the Claimed Saturation Sublimation Pressure State

Claim 1 also recites: "controlling the temperature and the pressure so that the whole of the third closed space may be in the saturated sublimation pressure state of the organic compound." US 704 does not teach or suggest this controlling step, as required by claim 1.

The specification discloses that in the claimed saturated sublimation pressure state, the vapor deposition of the organic compound is maintained at a constant temperature consistent with the temperature of the substrate, under a constant pressure. See the specification at p. 8, line 26 to p. 9, line 5. Thus, the "controlling the temperature and the pressure so that the whole of the third closed space may be in the saturated sublimation pressure state" step of claim 1 requires maintaining the space containing the vapor and the molded article at a constant temperature.

As discussed above, US 704 requires mixing the silicon source, the auxiliary, and a catalyst in a single container and sintering the mixture in that container to form the heater member. However, in contrast to claim 1, US 704 requires increasing the temperature of the

container in at least three temperature-increasing steps. In particular, US 704 requires: (i) first increasing the temperature of the container (and therefore of the mixture of the silicon carbide and the auxiliary) from room temperature to 700°C (see col. 8, lines 1-4); (ii) second, raising the temperature of the container from 700°C to 1500°C (see col. 8, lines 35-38); and (iii) third, raising the temperature of the container from 1500°C to a temperature of 2000°C to 2400°C (see col. 9, lines 4-7). See also col. 7, line 62 to col. 9, line 58, where US 704 describes in detail the sintering process.

Accordingly, US 704 does not teach or suggest : "controlling the temperature and the pressure so that the whole of the third closed space may be in the saturated sublimation pressure state of the organic compound," as required by claim 1. For at least this reason also, US 704 does not teach or suggest every feature of claim 1. Claims 2 and 3 depend from claim 1 and include all of its features. Accordingly, US 704 does not teach or suggest every feature of these dependent claims for at least the same reasons as claim 1.

C. US 704 Does Not Teach or Suggest the Criticality of the Claimed Saturation Sublimation Pressure State

For the reasons discussed above, the Office Action fails to establish a *prima facie* case of obviousness because US 704 fails to teach or suggest every feature of claims 1-3. However, even if the Office Action established a *prima facie* case of obviousness (which it has not), a showing of criticality is sufficient to overcome a *prima facie* case of obviousness. See, for example, *In re Albrecht*, 514 F.2d 1389, 1396, (CCPA 1975), *In re Papesch*, 315 F.2d 381 (CCPA 1963) and MPEP §§716.02-716.02(g).

The specification discloses that in conventional vapor deposition methods, the temperature of the vapor deposition source is set to be higher than the temperature of the article to be treated. See the specification at p. 4, line 25 to col. 5, line 4. The specification defines these conventional vapor deposition methods as non-equilibrium state methods, and

discloses that it is difficult to obtain uniform thickness of the vapor film on the article under such non-equilibrium conditions. See p. 5, lines 5-13.

The specification discloses that the claimed saturated sublimation pressure state overcomes the deficiencies of conventional vapor deposition methods. In contrast to the non-equilibrium conditions of conventional vapor deposition methods, the claimed saturated sublimation pressure state allows for the uniform application of the vapor deposition on the substrate. In other words, the claimed saturated sublimation pressure state is critical for obtaining a uniform thickness of the vapor film on the substrate.

Furthermore, as a supplement to the disclosed criticality of the saturation sublimation pressure state, the attached Declaration also demonstrates this criticality. Specifically, the attached Declaration discloses three separate experiments, each directly comparing articles prepared under saturated sublimation pressure state conditions with articles prepared under non-equilibrium conditions. In particular, the Declaration demonstrates that for articles prepared under saturated sublimation pressure state conditions, the vapor is uniformly deposited on the article. The Declaration further demonstrates that for articles prepared under non-equilibrium conditions, the vapor is not uniformly deposited. Thus, the attached Declaration also demonstrates that the claimed saturation sublimation pressure state is critical to the uniform deposition of the organic compound on an article.

Thus, even if the Office Action established a *prima facie* case of obviousness (which it has not), the specification's disclosure of criticality of the claimed saturation sublimation pressure state, along with the Declarations demonstration of this criticality, are sufficient to overcome such a *prima facie* case of obviousness.

D. Conclusion

For at least the reasons discussed above, claims 1-3 would not have been obvious over US 704. Accordingly, claims 1-3 are patentable over US 704. Reconsideration and withdrawal of the rejection are respectfully requested.

V. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-21 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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Attachment:
Declaration Under 37 CFR §1.132 of T. Mizokuro

Date: November 9, 2005

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